No. 15-1293

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IN THE

Supreme Court of the United States

MICHELLE K. LEE, DIRECTOR,
UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

—v.—

SIMON SHIAO TAM,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICI CURIAE* OF THE AMERICAN CIVIL LIBERTIES UNION, THE ACLU OF THE NATION'S CAPITAL, THE ACLU FOUNDATION OF OREGON, THE ASIAN AMERICAN LEGAL DEFENSE AND EDUCATION FUND, THE ASIAN PACIFIC AMERICAN NETWORK OF OREGON, THE CHINESE AMERICAN CITIZENS ALLIANCE, PORTLAND LODGE, THE PORTLAND JAPANESE AMERICAN CITIZENS LEAGUE, AND THE OREGON COMMISSION ON ASIAN AND PACIFIC ISLANDER AFFAIRS, IN SUPPORT OF RESPONDENT

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INTEREST OF *AMICI CURIAE*[1]

The **American Civil Liberties Union** ("ACLU") is a nationwide, nonprofit, nonpartisan organization with approximately 500,000 members dedicated to the principles of liberty and equality embodied in our nation's Constitution and civil rights laws. Since its founding in 1920, the ACLU has vigorously defended both free speech and racial justice. In specific instances, tensions arise between these two principles. However, nearly a century of experience has convinced the ACLU that a strong First Amendment is not only compatible with equality but essential to its pursuit. Many of the landmark civil rights decisions of the 1950s and 1960s arose out of free speech controversies, *see, e.g.*, *Shuttlesworth v. City of Birmingham*, 394 U.S. 147 (1969), freedom of speech and association have long been important tools for disadvantaged minorities to seek equal treatment, and efforts to suppress particular viewpoints are often aimed at racial and ethnic minorities.

To preserve the principle of viewpoint neutrality, the ACLU and its affiliates have appeared in countless cases throughout the country. The ACLU participated as *amicus* and presented oral argument in this case to the *en banc* Court of Appeals. Accordingly, the proper resolution of this case is a matter of substantial interest to the ACLU

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[1] All parties have given blanket consent to the filing of *amicus* briefs in this case. No party has authored this brief in whole or in part, and no one other than *amici*, their members, and their counsel have paid for the preparation or submission of this brief.

and its members. The **American Civil Liberties Union of Oregon** is a state affiliate of the national ACLU. The **American Civil Liberties Union of the Nation's Capital** is the Washington, D.C. affiliate of the national ACLU.

The **Asian American Legal Defense and Education Fund** ("AALDEF"), founded in 1974, is a national organization that protects and promotes the civil rights of Asian Americans. AALDEF recognizes the harmful impacts of racial slurs and hateful speech on Asian Americans and opposes stereotypes that stigmatize the Asian American community. At the same time, AALDEF believes that Section 2(a) of the Lanham Act violates the First Amendment. The Act grants unbridled discretionary power to the United States Patent and Trademark Office ("PTO") to determine what may "disparage" Asians Americans and other racial and ethnic groups. This broad authority should not be used to disadvantage groups in political disfavor with the government and minorities seeking to challenge and reclaim racist language.

The **Asian Pacific American Network of Oregon** ("APANO") is a statewide, grassroots organization, uniting Asians and Pacific Islanders to achieve social justice. APANO envisions a just and equitable world where Asians and Pacific Islanders are fully engaged in the social, economic, and political issues that affect the community. APANO has worked for 20 years engaging Asian and Pacific Islander citizens in the electoral process, providing language access, and increasing opportunities for civic participation. Protecting free speech and self-expression is essential to building an equitable

society in which all members can fully participate as citizens. The PTO has placed undue burdens on historically marginalized communities whose voices are disproportionately suppressed through their actions. APANO aims to encourage messages of racial justice without concerns of government misinterpretation or abridgement of rights.

The **Chinese American Citizens Alliance, Portland Lodge** is a social fraternal organization providing community service, promoting civil engagement, and developing youth leadership through scholarships, education and recreational programming. Since its inception in 1895, the Chinese American Citizens Alliance ("C.A.C.A.") has stepped forward to promote citizenship, better the community, and combat ongoing anti-Chinese sentiment. Among the C.A.C.A.'s most important and enduring missions is the defense of civil rights and immigration rights of Chinese and Chinese-Americans, and the struggle against stereotyping, ethnic discrimination, and racial profiling. The Portland Lodge is the Portland chapter of the C.A.C.A.

The **Portland Japanese American Citizens League** strives to promote diversity and social justice, and monitors and responds to issues that threaten the civil and human rights of all Americans. The Japanese American Citizens League ("JACL"), founded in 1929, is the oldest and largest Asian American civil rights organization in the United States. The Portland JACL is a 501 (c)3 affiliate of the national JACL in Washington, D.C., and serves members in the Portland and southwest Washington areas. The events of September 11, 2001 created a

worldwide climate of insecurity and new threats to civil liberties. The Portland JACL has reached out to Muslim Americans and other targeted communities to offer partnership, supported the LGBTQ community's efforts to obtain equal rights in marriage and public accommodations, and objected to a line of Adidas shoes featuring a buck-toothed slant-eyed character with a bowl haircut. The Portland JACL protested when the city of Gresham proposed honoring a former mayor who advocated for the removal of Japanese Americans from the west coast and a constitutional amendment to revoke their citizenship. The Portland JACL supports Respondent Simon Tam's wish to obtain a trademark for his band, The Slants. The band's intention is to take ownership of a disparaging term and to exercise its First Amendment right of free speech. The Portland JACL is concerned that government attempts to determine "offensiveness" have disparate impacts on communities and individuals of color.

The **Oregon Commission on Asian and Pacific Islander Affairs** ("OCAPIA") is an eleven-member advisory group of nine community leaders appointed by the Governor and two Oregon legislators appointed by the President of the Senate and the Speaker of the House for the purpose of advising on policy issues that affect the success of the Asian and Pacific Islander community statewide, including lowering barriers and assuring equity in policy matters. OCAPIA has known and worked with Respondent Simon Tam around his efforts regarding the name "The Slants" for a number of years as an emerging trademark issue, through the appeal with the PTO, and now as a broader issue of the rights of minority and ethnic communities to reclaim use of

words that define, in part, their self-identification in American society. During this period, OCAPIA has received regular reports from Mr. Tam about his case with the PTO, has written to the PTO requesting an equitable review of Mr. Tam's appeal, and now joins as *amicus* in support of his case.

SUMMARY OF ARGUMENT

Few principles of constitutional law are as settled as the First Amendment's prohibition against government regulation of private speech based on viewpoint. The First Amendment precludes the government from discriminating on the basis of viewpoint whether it is imposing direct punishments, *Texas v. Johnson*, 491 U.S. 397, 414 (1989); regulating access to a public or even a nonpublic forum, *Lamb's Chapel v. Center Moriches Union Free School District*, 508 U.S. 384, 393–94 (1993); or allocating subsidies for private expression, *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 547–49 (2001). This rule holds no less true in the context of intellectual property. Just as the First Amendment would not tolerate the granting of copyrights only to works that convey views a government censor approves, so it cannot tolerate the selective registration of trademarks on that basis.

The Lanham Act, 15 U.S.C. § 1052(a) (hereinafter "Section 2(a)"), facially discriminates on the basis of viewpoint in the registration of trademarks. It denies registration to marks that the PTO interprets to "comprise[ ] immoral . . . or scandalous" matter or matter that "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols," while permitting registration of

marks that celebrate those same persons, institutions, beliefs, or national symbols. Section 2(a) casts government officials in the impermissible role of language police, directing them to benefit favored viewpoints while denying the same benefits to disfavored viewpoints on the same subject.

Registration provides substantial benefits to the trademark holder, and trademarks are often intended and understood to convey a message or idea. Indeed, it is precisely because Respondent Simon Tam's trademark expresses what the United States Patent and Trademark Office ("PTO") considers a politically unacceptable idea that it was denied registration. This Court has held that the government may not distribute benefits to private speech based on approval or disapproval of its viewpoint. Just as it would be an impermissible "power of censorship" to deny mailing privileges to a magazine because its content was deemed morally "good" or "bad," *Hannegan v. Esquire, Inc.*, 327 U.S. 146, 151 (1946), so, too, it is impermissible for the PTO to deny registration to marks that it considers "disparaging."

Petitioner contends that it can discriminate in this manner because the denial of trademark registration does not restrict speech, but merely denies a benefit. But the prohibition on viewpoint discrimination applies equally to the distribution of benefits to private speech as to the imposition of penalties. And the system for registering trademarks, like that for registering copyrights, is manifestly designed to promote and support a diversity of private expression, and not to express a government message. Here, as in copyright and all

other government regulation of private speech, the government must remain viewpoint-neutral.

A system of government benefits distributed based on assessments of whether private speech disparages individuals, institutions, beliefs, or national symbols will inevitably reflect the subjective judgments of the government officials involved. As demonstrated by this case, such judgments may hinder members of racial minorities from attempting to use and change the meaning of language, and may treat trademarks differently depending on the identity of the speaker. The PTO denied registration here in part because the applicant is Asian-American, and in part because the PTO did not appreciate the applicant's attempt to reappropriate the term "slants" as a political act.

The constitutional harms caused by Section 2(a) are magnified by its vague and subjective terms. A prohibition on disparaging persons, institutions, beliefs, or national symbols provides no meaningful notice to speakers as to what speech the government will find acceptable. The vague standards of Section 2(a) have produced arbitrary and irreconcilable results, with the same mark being accepted for some applicants but rejected for others in similar contexts. Such results are a telltale sign that Section 2(a) cannot pass constitutional muster. The chilling effect of Section 2(a) is greatly exacerbated by the fact that its strictures are subject to continual reconsideration. The provision allows the PTO to find a mark disparaging at any point in time, even if it was not deemed disparaging at the time of registration. Thus, a trademark applicant must guess not only at what a PTO official might find disparaging today, but at

what some future official may find disparaging years from now.

In denying Respondent the benefit of registering The Slants' mark because of the PTO's conclusion that the band's name expresses a disparaging viewpoint, the government violated the First Amendment. The Court should end this system of viewpoint discrimination by striking down Section 2(a)'s prohibition on the registration of "disparag[ing]" marks.[2]

ARGUMENT

I. SECTION 2(A) OF THE LANHAM ACT REGULATES PRIVATE SPEECH ON THE BASIS OF VIEWPOINT.

The Lanham Act discriminates against private viewpoints protected by the First Amendment by prohibiting the registration of trademarks that the government deems immoral, scandalous, or disparaging. Section 2(a) distributes government

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[2] Although the constitutionality of Section 2(a)'s disparagement clause is the only question before the Court, the portion of Section 2(a) that bars registration of marks comprising "immoral" or "scandalous" matter, *see* 15 U.S.C. § 1052(a), suffers from the same constitutional infirmities because it is a viewpoint-based, vague regulation of speech. In a separate case pending before the U.S. Court of Appeals for the Federal Circuit, the government took the position that "in view of the totality of the [Court of Appeals'] reasoning" in holding the disparagement clause facially unconstitutional in *In re Tam*, there was no "reasonable basis . . . for treating [the "immoral" and "scandalous" portion] differently." *See* Letter from Appellee Lee Responding to Court Order of December 22, 2015 at 1–2, *In re Brunetti*, No. 15-1109 (Fed. Cir. Jan. 1, 2016).

benefits only after a government official has assessed the message communicated by a putative trademark and determined that it does not express an unacceptable viewpoint. If a trademark celebrates a person, institution, belief, or national symbol, it may be registered, but a trademark that expresses a "disparaging" view about the same subject matter will be denied registration. It is axiomatic that the government may not regulate private expression based on its viewpoint; viewpoint discrimination triggers strict scrutiny and is presumptively invalid. *Good News Club v. Milford Cent. Sch.*, 533 U.S. 98 (2001); *Rosenberger v. Rectors and Visitors of Univ. of Virginia*, 515 U.S. 819 (1995), 828–29. By mandating viewpoint-based discrimination, Section 2(a) violates the First Amendment.

Trademark applicants often propose marks explicitly intended to define a group identity,[3] engage in parody,[4] convey artistic ideas,[5] or (as here) express a political opinion. Accordingly, the registration of trademarks must comport with traditional First

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[3] For example, "American Civil Liberties Union" and "ACLU" are federally registered trademarks that, among other things, convey a message about the values and identity of one of the *amici curiae* filing this brief.

[4] *See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (concluding that the trademark for "Chewy Vuitton" dog toys was "a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general").

[5] *Cf. Rogers v. Grimaldi*, 875 F.2d 994, 998 (2d Cir. 1989) (noting that film titles are "of a hybrid nature, combining artistic expression and commercial promotion").

Amendment protections. *See, e.g., Radiance Foundation, Inc., v. NAACP*, 786 F.3d 316, 321–22 (4th Cir. 2015).

The plain language of Section 2(a) requires viewpoint discrimination. Its prohibition on registration for "immoral," "scandalous," or "disparag[ing]" trademarks is aimed at avoiding controversy—any determination under the section explicitly turns on whether a government official believes that the public (or some fraction of it) would consider a mark offensive. In effect, Section 2(a) codifies a preemptive heckler's veto. But this Court has held that "the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable." *Johnson*, 491 U.S. at 414; *see also Coates v. Cincinnati*, 402 U.S. 611, 615 (1971) ("public intolerance or animosity cannot be the basis for abridgment of these constitutional freedoms"). In denying registration of any mark that "disparages" any group or institution, but not those that praise them, Section 2(a) engages in classic viewpoint discrimination.

This case exemplifies the expressive nature of trademarks denied registration under Section 2(a) of the Lanham Act—and the power of the viewpoints they can express. While some use the word "slant" to degrade, others—such as Respondent Simon Tam and his band—use the term as a means of empowerment. Reappropriation of terms often used negatively is a powerful tool employed by numerous social justice movements to neutralize offensive words and take ownership of their own stories and

language. [6] Reappropriation by its very nature involves strategic use of a disparaging word in the hope that, over time, the word may lose its negative power, at least in certain contexts. A robust debate may exist within the very community that is the target of a disparaging term over whether reappropriation is possible, desirable, or effective, and individuals who attempt such reappropriation may find themselves holding a minority viewpoint within their own community. *See* Brief for Asian Americans Advancing Justice et al. as *Amici Curiae* In Support of Neither Party ("AAJC Brief") at 13 (arguing that "'reclamation' only makes sense because 'slants' has a disparaging meaning in reference to Asian Americans *now*"). The affected community, or society at large, may eventually come to accept that certain uses of disparaging terms are socially acceptable, but that acceptability can rest on

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[6] *See* Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After* Lawrence v. Texas, 9 Marq. Intell. Prop. L. Rev. 187, 191 n.18 (2005) ("Although 'queer' has historically denigrated homosexuals, it has evolved . . . to reflect the recent renunciation of its negative uses and the reclamation of the term by sexual minorities.") (citation omitted). Reappropriation is a process that the PTO has itself recognized in certain instances, albeit inconsistently. *See, e.g.*, DYKES ON BIKES, Registration No. 3323803 (initially rejected on the ground that the term "dyke" was considered vulgar, offensive, or disparaging but later accepted for registration after the trademark holder submitted evidence that the term "dyke" can be used as a source of pride and identity for the LGBT community). *But see In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) (rejecting the proposed trademark "Heeb" as used for a magazine that focuses on Jewish culture and is marketed to young Jewish people).

complex distinctions including the identity of the speaker, the intent of the speech, and the context in which it is made.[7]

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[7] The brief of *amici curiae* Asian Americans Advancing Justice et al., argues that "the Lanham Act is not pro-speech," and that "[b]y expanding the exclusive nature of a trademark, federal registration of marks actually inhibits speech by *precluding* their use by anyone else." AAJC Brief at 11; *see also* Brief of Amanda Blackhorse et al., as *Amici Curiae* In Support of Petitioner at 9–12. *Amici* recognize that the Lanham Act is itself a restriction on speech, and that exclusive intellectual property rights may prevent others from using expressive marks in certain circumstances. But it does not follow that viewpoint discrimination creates no constitutional problem because a denial leaves more speakers free to use the mark. As the government points out, denial of registration *does not* leave others free to use the mark. *See* Pet'r's Br. 19–21. But even if it did, benefits to other speakers do not justify viewpoint discrimination against disfavored speakers. *See Rosenberger*, 515 U.S. at 835 (explaining that scarcity of funds to allocate among speakers did not excuse viewpoint discrimination in the allocation).

Nor should trademark registration "freez[e] pejorative meanings in place and remov[e] derogatory terms from communal debate and actual control by the groups targeted by a disparaging mark," even if the registration is granted to an entity that is not a member of the disparaged group. AAJC Brief at 11. A person with a registered mark may not prevent others from engaging in criticism or political advocacy related to the mark, including a boycott of the marked product. Furthermore, trademark law contains protections that ensure registration does not serve as a stranglehold on critical speech *containing* registered marks. The Lanham Act provides a fair use defense to dilution liability for marks that serve as parody, criticism, or commentary, for news reporting and commentary, and for noncommercial use of marks. 15 U.S.C. § 1125(c)(3). The cure for the pressures that an intellectual property regime places on speech lies in protecting ample breathing room for the

It cannot be the government's role to distribute official benefits on the basis of evaluations of such highly subjective inquiries as whether a trademark applicant's intended use of a particular mark adequately eliminates its offensiveness. Indeed, attempts to determine whether an applicant has "successfully" reappropriated a word raise the specter of speaker-based discrimination, in which the government allocates the benefits of trademark registration on the basis of the speaker's perceived identity or status within a particular community.

In this case, the PTO predicated its rejection of Respondent's trademark in part on the mark's relation to Mr. Tam's race. *See* J.A. 36 ("the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark—as the name of an all Asian-American band"). At the same time, the PTO has registered many other marks using "slant" or variations thereof. *See, e.g.*, "Slant," Registration No. 3,437,230 (serving-ware for food); and former Registration Nos. 2,163,769 (art and graphic design services); 2,081,228 (education services); 1,511,492 (insecticides) (all later cancelled for reasons unrelated to disparagement). Here, the speaker's identity was an explicit factor used by the PTO in determining the registrability of the mark. Like viewpoint discrimination, this form of speaker-based

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fair use of registered trademarks. The cure is not—and cannot be—a free-floating rule that mandates the provision of substantial government benefits only to those who hold right-thinking viewpoints or use government-approved words.

discrimination is impermissible under the First Amendment. *See Rosenberger*, 515 U.S. at 828 ("In the realm of private speech or expression, government regulation may not favor one speaker over another.").

The government offers virtually no support for its contention that the ban on "disparaging" marks is viewpoint-neutral. Pet'r's Br. 43–48. It suggests that laws against "libel, threats, or 'fighting words' likewise distinguish in a general way between speech that is critical or hostile and speech that is complimentary or conciliatory." *Id.* at 44–45. But these are categories of *unprotected* speech; they hardly stand for the proposition that the government can regulate *protected* speech on the basis of whether it offends. *See Johnson*, 491 U.S. at 416–17 (striking down conviction for flag desecration, defined as an act that would "seriously offend" observers). If the refusal to fund "religious activity" is viewpoint discrimination because it singles out religious perspectives, *Rosenberger*, 515 U.S. at 832, then surely a refusal to register marks that "disparage" particular individuals, institutions, beliefs, or national symbols also discriminates on the basis of viewpoint.

II. SECTION 2(A) OF THE LANHAM ACT PLACES AN UNCONSTITUTIONAL CONDITION ON THE RECEIPT OF VALUABLE GOVERNMENT BENEFITS.

The government's principal defense of Section 2(a) is that it does not restrict speech because it merely denies a government benefit, and leaves Respondent free to use the term "Slants" without the

protections trademark registration provides. This argument fails, however, because the prohibition on viewpoint discrimination extends not only to the direct prohibition of speech, but also to conditions on the distribution of government benefits. The only exception to this rule is when the government itself is speaking, and the Lanham Act is a regulation of private speech, not a form of government speech.

A. The Government May Not Discriminate On The Basis Of Viewpoint In Allocating Government Benefits To Private Speech.

The Court has long recognized that the government cannot violate speech rights through the discriminatory allocation of government support. Viewpoint discrimination is prohibited not only when the government punishes speech outright, but also when it distributes benefits to private speech, *Velazquez*, 531 U.S. at 547–49, or regulates access to a public or nonpublic forum, *Good News Club*, 533 U.S. at 107.

For this reason, a public university may not discriminate in allocating funds to student groups on the basis of a group's viewpoint. *See Rosenberger*, 515 U.S. at 835. And on similar grounds, the Court invalidated a restriction on government-funded legal services lawyers that imposed a viewpoint restriction, barring funded lawyers from challenging the constitutionality of welfare legislation. *See Velazquez*, 531 U.S. at 548–49.

The Court has long rejected the argument that when the government is merely distributing benefits

rather than imposing criminal penalties, it is free to discriminate on the basis of private speakers' viewpoints. *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2330–32 (2013) (invalidating condition on private speech attached to federal funding of AIDS prevention); *Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech"). In particular, the government may not use a subsidy to seek to control private expression by discriminating against disfavored viewpoints.

Indeed, the cases the government relies on underscore the point. The government cites *Regan v. Taxation With Representation of Washington*, 461 U.S. 540 (1983), in which the Court upheld a federal statute that limited certain tax benefits to the non-lobbying activities of charitable organizations. As the Court later explained in *Rosenberger*, 515 U.S. at 834, the validity of that program turned on the fact that it was viewpoint-neutral. There can be little doubt that if the statute had barred tax benefits to lobbyists whose views the IRS found "disparaging," it would have been unconstitutional. Similarly, had the payroll-deduction mechanisms upheld in *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177 (2007), and *Ysursa v. Pocatello Educ. Ass'n*, 555 U.S. 353 (2009), limited unions' use of dues for political activities only when a state official deemed those activities "non-disparaging" of any "person, institution, belief, or national symbol," they, too, would have been invalid as viewpoint discrimination. The government's examples only underscore the critical mandate of viewpoint neutrality, one that Section 2(a) contravenes on its face.

Thus, the government's oft-repeated assertion that it is simply distributing benefits, and not restricting speech, Pet'r's Br. *passim*, is unavailing where, as here, it discriminates on the basis of viewpoint in supporting private speech. If that argument were sufficient to uphold this scheme, then the First Amendment would also permit the government to distribute copyright protections based on a government official's assessment of whether the work in question was "disparaging," "immoral," or "scandalous." It does not; trademark is the only intellectual property regime where such viewpoint-discriminatory rules persist.

B. Section 2(a)'s Viewpoint Discrimination Is Not Permissible As A Form Of Government Speech Or Because It Regulates A Government Program.

The only exception to the rule against viewpoint discrimination in support of speech concerns programs where the government funds private parties to spread its own message. In *Rust v. Sullivan*, the government was permitted to condition eligibility for Title X funds on recipients agreeing not to use those funds to advocate abortion because the program was a government speech program. 500 U.S. 173, 193 (1991). As the Court later explained in *Rosenberger*, in the Title X program at issue in *Rust*, "the government did not create a program to encourage private speech but instead used private speakers to transmit specific information pertaining to its own program." 515 U.S. at 833. The Court further noted that "when the government appropriates public funds to promote a particular

policy of its own it is entitled to say what it wishes." *Id.*

The government relies on these governnment speech cases to defend the Lanham Act. *See* Resp't's Br. 31–35. But Section 2(a) governs purely private speech, and in no way constitutes a government speech program. Trademarks are private speech, not government speech. This Court has set forth a test for determining whether speech belongs to a private speaker or the government; by every metric of that test, trademarks constitute private expression. *See Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2248–50 (2015). First, the government has never purported to convey a message through a trademark. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 at *5 n.3 (1993) (rejecting the notion that registration constitutes the government's endorsement of the mark or the product to which it is affixed). Second, as any consumer who has purchased plastic bricks from Legos,[8] tissues from Kleenex,[9] or chocolate bars from Hershey's [10] can vouch, the public identifies trademarks with the mark-holder or its product, and not with the government. Finally, the trademark registrant maintains final control over the mark's design or use; the PTO has no design role whatsoever, and plays no role in the mark's use for expressive purposes. Under no meaning of the term can "The Slants" be deemed government speech.

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[8] Registration No. 4,395,578.

[9] Registration No. 4,715,059.

[10] Registration No. 4,529,672

Thus, Section 2(a) does not constitute the use of government funds for the purpose of furthering *government* speech, but instead grants benefits to private speakers who express viewpoints that government officials deem unobjectionable.

Nor does the fact that the government administers the registration program or publishes the Principal Register change the analysis. As the court below correctly found, the appropriate analogy for the Principal Register is not to the government-issued license plates at issue in *Walker*, 135 S. Ct. at 2239, but to government-issued parade permits or copyrights. In the latter contexts, the government's administrative actions do not give it leeway to discriminate against private speech. A holding otherwise would open the door to a flood of unconstitutional censorship in the name of avoiding government involvement with disfavored private speech.

The government's argument that any time it expends resources to administer a program it can impose viewpoint-based eligibility requirements would eviscerate existing First Amendment protections. *See* Pet'r's Br. 9. It would permit cities and towns to deny parade permits to groups whose messages they deem "disparaging" or otherwise offensive. *But see Forsyth Cty., Ga. v. Nationalist Movement*, 505 U.S. 123, 134–35 (1992) (striking down ordinance tying cost of protecting protestors to permit fee and thereby enabling city to charge controversial speakers more). It would authorize the Postmaster General to deny mailing privileges to "immoral" magazines. *But see Hannegan*, 327 U.S. at 159. It would allow government to mandate or

prohibit speech on any product it regulates, circumventing the tailoring rules of commercial speech doctrine. *But see Rubin v. Coors Brewing Co.*, 514 U.S. 476, 485 (1995) (regulation of alcohol labels by Bureau of Alcohol, Tobacco and Firearms did not permit government to prohibit truthful advertising on labels, despite the "social harm" caused thereby). And it would permit the IRS to deny tax benefits to those who lobby for politically unacceptable views. *But see Rosenberger*, 515 U.S. at 834 (explaining that limit on tax benefits for lobbying in *Regan* turned on its viewpoint neutrality). The government's administrative operation of a program does not permit it to regulate private speech on the basis of viewpoint.

III. SECTION 2(A) IS UNCONSTITUTIONALLY VAGUE AND LEADS TO ARBITRARY TRADEMARK DETERMINATIONS.

The invalidity of Section 2(a)'s viewpoint discriminatory standards is exacerbated by their vagueness. Where a content-based law is also vague, it creates an "obvious chilling effect." *Reno v. American Civil Liberties Union*, 521 U.S. 844, 871–72 (1997).[11]

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[11] This Court has examined statutes that vest unbridled discretion to regulate speech under both the First Amendment and the Due Process Clause. "It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined." *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972). The requirement of clarity is especially stringent when a law interferes with First Amendment rights. *See Keyishian v. Bd. of Regents*, 385 U.S. 589, 604 (1967). The Constitution requires the government to

Section 2(a) provides little guidance to the PTO as to the meaning of "disparaging," "scandalous," or "immoral," leading to a long line of arbitrary and contradictory decisions. The Trademark Manual of Examining Procedure ("TMEP") states that in evaluating whether a mark is disparaging, trademark examiners should consider the potential offensiveness of a mark to a "substantial composite" of the potentially offended group. TMEP § 1203.03(b). But the manual offers no further guidance as to how to identify such a "substantial composite," or how to determine whether that "substantial composite" considers the mark disparaging. It effectively requires the examiner first to hypothesize an audience and then to guess at the hypothetical audience's reaction to a particular term. The legislative history of the Lanham Act provides no further explanation. While it is sometimes the case that "[a] term that appears vague on its face may derive much meaningful content from the purpose of the Act, its factual background, and the statutory context," *Thomas v. Union Carbide Agric. Products Co.*, 473 U.S. 568, 593 (1985) (citation omitted), no such purpose, background, or context helps to clarify Section 2(a).

The lack of clear standards is exemplified by the PTO's long history of bizarre and contradictory decisions: The very same terms have been granted registration in one case and denied in another with no seeming continuity of logic. For example:

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define restrictions on speech with clarity *both* to ensure procedural fairness and to avoid chilling speech.

- The PTO rejected "Wanker" for use on clothing,[12] but registered it for use on beer.[13]
- The PTO rejected "Titmouse" for use on computer cursor control devices, [14] but "TitmouseInc." is a registered mark used for animation production services.[15]
- The PTO rejected "Madonna" as a trademark for wine as scandalous, [16] but accepted a different "Madonna"—also for the sale of wine.[17]
- The PTO rejected "Pussy Power" as a mark for entertainment services, [18] but accepted "PussyPowerRevolution" for use on clothing.[19]
- The PTO rejected "Cocaine," for use on soft drinks,[20] but accepted it for use on clothing.[21]

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[12] U.S. Trademark Application Serial No. 78,610,369 (filed Apr. 16, 2005). All of these examples were deemed barred by Section 2(a)'s prohibition on "immoral," "scandalous," or "disparaging" viewpoints.

[13] Registration No. 2,036,108.

[14] U.S. Trademark Application Serial No. 78,954,967 (filed Aug. 18, 2006).

[15] Registration No. 4,624,689.

[16] *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938).

[17] Registration No. 3,545,635.

[18] U.S. Trademark Application Serial No. 77,387,209 (filed Feb. 2, 2008).

[19] Registration No. 4,507,246.

- The PTO rejected "The Complete A**hole's Guide To . . ." as a trademark for a series of books providing information relating to advice, counseling, self-help, and humor, [22] but it deemed acceptable "Managing Your Inner A**hole," for books on the development of emotional intelligence.[23]

- The PTO rejected "Messias" for wine and brandy, [24] but granted registration to "Il Messia" for wine.[25]

In light of this decisional patchwork, no trademark applicant can ever be on notice as to what words or ideas will trigger PTO rejection—much less revocation decades later. The PTO's sole limiting principle in applying Section 2(a) requires an examining attorney who believes a pending trademark is scandalous or immoral to "consult with his or her supervisor" if she believes, "for whatever reason, that a mark may be considered to comprise such matter," in order to "ensure consistency in examination with respect to immoral or scandalous

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[20] U.S. Trademark Application Serial No. 78,829,207 (filed March 3, 2006).

[21] Registration No. 1,340,874.

[22] U.S. Trademark Application Serial No. 76,351,811 (filed December 21, 2001).

[23] U.S. Trademark Application Serial No. 85,711,056 (filed August 23, 2012) (not registered on other grounds).

[24] *In re Sociedade Agricola E. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968).

[25] Registration No. 4,093,035.

matter." TMEP § 1203.01. The disparagement clause lacks even this regulatory attempt at consistency. And this procedural step ultimately fails to ensure that the PTO applies Section 2(a)'s standards consistently, as the examples cited above demonstrate. The only consistent result of the application of the disparagement clause is inconsistency.

Furthermore, the PTO's perpetual ability to revisit the offensiveness of existing trademarks greatly exacerbates the problems of insufficient notice and chilling effect. Applicants not only have to guess what the PTO may find scandalous, immoral, or disparaging today, but also what it may find objectionable years from now—long after substantial resources have been invested in establishing a recognizable mark. Those who wish to register an expressive mark must therefore make their best guess about how to survive the timeless gauntlet of Section 2(a)'s moral judgment—by self-censoring.

What may be deemed acceptable today may become disparaging tomorrow, depending on the PTO's perception of changing social mores, or indeed based on a change in the government's viewpoint itself. As such, Section 2(a) is impermissibly vague and grants government power to regulate without sufficient guidance, resulting in inconsistent and unconstitutional administrative action.

IV. HOLDING THAT SECTION 2(A) IS FACIALLY UNCONSTITUTIONAL WOULD NOT SIGNIFICANTLY ALTER THE LANDSCAPE OF TRADEMARK LAW AND WOULD BRING TRADEMARK IN LINE WITH COPYRIGHT.

A finding of unconstitutionality in this case requires only a narrow remedy that will not create upheaval in existing trademark law. In fact, striking down the disparagement clause will bring trademark law more closely in line with copyright and patent law, both of which secure intellectual property rights without making *ad hoc* moral judgments about the acceptability of viewpoints that private speakers express.

As the copyright regime demonstrates, offensive ideas promulgated by private individuals are not incompatible with a sound system of regulating intellectual property. To the contrary, other intellectual property regimes rightly refuse to draw viewpoint- or content-based distinctions. "Congress has enacted two statutory copyright restrictions that were arguably content based, but afterwards repealed them." *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 855 n.4 (5th Cir. 1979); *see also, e.g., Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802–03 (1977) (reversing the morality-based rejection of a patent for a slot machine). "The gravity and immensity of the problems, theological, philosophical, economic and scientific, that would confront a court" asked to determine whether or not a given expression is worthy of copyright protection would be "staggering to contemplate." *Belcher v. Tarbox*, 486 F.2d 1087, 1088 (9th Cir. 1973). In

requiring government officers to make necessarily subjective judgments about the acceptability of private viewpoints. Section 2(a)'s regulation of trademarks is a clear outlier. *See Mitchell Bros.*, 604 F.2d at 855 n.4; *Belcher*, 486 F.2d at 1088.

While many copyrighted works are undoubtedly offensive or disparaging to some subset of society, the government wisely refrains from selectively offering the benefit of copyright protection based on viewpoint, and instead leaves such judgments to the marketplace of ideas. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (Holmes, J.) (declining to become the "final judges of the worth of" any particular expressions, instead entrusting that decision to the public marketplace).

Trademark registration should be treated the same way. Instead of wading into what society does or does not deem acceptable at a given moment in history, the government should allow movements led by artists and activists like The Slants to run their course, and for those who disagree with a trademark's message—whether of disparagement or attempted reappropriation—to express that disagreement through protected expression of their own.

CONCLUSION

For the reasons stated above, this Court should hold that the portion of Section 2(a) barring the registration of disparaging marks is unconstitutional.

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